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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,831	06/12/2008	Mark Alexander Gregory	750055.401USPC	8386

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SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
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SEATTLE, WA 98104

EXAMINER

ANDERSON, FOLASHADE

ART UNIT	PAPER NUMBER
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3623

MAIL DATE	DELIVERY MODE
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06/24/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/594,831

Applicant(s)

GREGORY, MARK ALEXANDER

Examiner

FOLASHADE ANDERSON

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4, 12-15, 23 and 24 is/are rejected.
7) ☒ Claim(s) 5-11 and 16-22 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. The following Office Action in response to the communication received on 09/28/2006.

Status of Claims

2. Claims 1-24 are pending in this application.

Information Disclosure Statement

3. The information disclosure statements (IDS) submitted on 008/11/2008 was considered by the Examiner in the prosecution of the claims in the instant application.

Claim Objections

4. Claims 5-11 and 15-22 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim, the dependent claims cannot depend from any other multiple dependent claims. See MPEP § 608.01(n).

Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based upon consideration of all of the relevant

factors with respect to the claim as a whole, claim(s) 19 held to claim an abstract idea, and is/are therefore rejected as ineligible subject matter under 35 U.S.C. 101. The rationale for this finding is explained below:

In order for a method to be considered a "process" under §101, a claimed process must either comply with the "machine-or-transformation test" (1) be tied to a particular machine or apparatus or (2) transform a particular article to a different state or thing. *Bilski v. Kappos*, 95 USPQ2d 1001 (U.S. 2010); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to independent claim 1, the claim language recites the steps of obtaining, creating, updating, storing, etc., however the claim language does not include the required tie or transformation.

Dependent claim(s) 2-4 when analyzed as a whole are held to be patent ineligible under 35 U.S.C. 101 because the additional recited limitation(s) fail(s) to establish that the claim(s) is/are not directed to an abstract idea, thus are rejected based upon the same rationale, wherein the claim language does not include the required tie or transformation.

7. Claims 12-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed towards computer software, which is a non-statutory class. While Applicant goes on to recite in the claim

"the computer software residing on a computer-readable medium" the claim when taken as a whole is software per se.

To correct the statutory class it is suggested that Applicant amend the preamble of claim 12 as follows: "~~Computer software for integrating systems engineering and project management tools, the computer software residing on a computer-readable medium~~ and including with instructions stored thereon for causing a computer to perform the following operations:"

For purposes of examination it is assumed that the statutory class is that of a manufacture, i.e. computer-readable medium.

8. Claim 24 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed towards computer software, which is a non-statutory class.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

For purposes of examination the reasoning used in claims 1 and 12 also applies to claims 23 and 24; since the claims are substantially unclear.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1,2, 4, 12, 13, 15, 23 and 24 rejected under 35 U.S.C. 102(b) as being anticipated by Bentley et al (US 5,987,242 A).

13. Claims 1, 12, 23 and 24

Bentley teaches a method for integrating systems engineering and project management tools, the method including the steps of:

- obtaining component parts and life cycle activities of a system (Bentley col. 12, lines 33-35 where the class definition if the same a part and col. 2, lines 18-21);
- creating a system information model by selectively and individually linking parts and activities with tasks, resources, time and costs (Bentley col.14, lines 38-58);
- updating the system information model by selectively and individually adding or modifying parts, activities, tasks, resources, time, costs and links there between (Bentley col. 40, lines 28);
- storing versions of the system information model; processing versions of the system information model into end-user information to enable life cycle analysis of the system (Bentley col. 43, lines 22-29).

With respect to claim 12 which is the computer readable medium used in the implementation of the method it is implied in and depended upon the method.

Therefore the computer readable medium is rejected based on similar reasoning to that given above.

With respect to claims 23 and 24 which are drawn to a method and software respectively are also rejected based on the reasoning given above with respect to claim 1.

14. Claims 2 and 13

Bentley teaches all the limitations of the method according to claim 1, wherein the method is implemented as an add-in or plug-in to a project management application (Bentley col. 31, lines 10-15).

With respect to claim 13 which is the computer readable medium used in the implementation of the method it is implied in and depended upon the method. Therefore the computer readable medium is rejected based on similar reasoning to that given above.

15. Claims 4 and 15

Bentley teaches all the limitations of the method according to claim 2 or 3, wherein the system information model accesses tasks, resources, time and costs from the project management application (Bentley col. 48, lines 59).

With respect to claim 15 which is the computer readable medium used in the implementation of the method it is implied in and depended upon the method. Therefore the computer readable medium is rejected based on similar reasoning to that given above.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bentley et al (US 5,987,242 A) in view of Official Notice

18. Claims 3 and 14

Bentley teaches all the limitations of the method according to claim 2, however Bentley does not teach wherein the project management application is at least one of Microsoft Project TM, Artemis® and Primavera®.

Official Notice is taken that the Microsoft Project TM, Artemis® and Primavera® where all very old and well known commercially available project management application. Therefore the following limitation, wherein the project management application is at least one of Microsoft Project TM, Artemis® and Primavera®, would have been obvious to one of ordinary skill in the art at the time the invention was made.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Bentley wherein the project management application is at least one of Microsoft Project TM, Artemis® and Primavera® as taught by Official Notice since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function

as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

With respect to claim 14 which is the computer readable medium used in the implementation of the method it is implied in and depended upon the method. Therefore the computer readable medium is rejected based on similar reasoning to that given above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FOLASHADE ANDERSON whose telephone number is (571)270-3331. The examiner can normally be reached on Monday through Thursday 8:00 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Folashade Anderson/
Examiner, Art Unit 3623

/BETH V BOSWELL/
Supervisory Patent Examiner, Art Unit 3623